

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	79162545
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 105
<b>MARK SECTION</b>	
<b>MARK FILE NAME</b>	http://tmng-al.uspto.gov/resting2/api/img/79162545/large
<b>LITERAL ELEMENT</b>	SMART SHIFT AND DRIVE
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>COLOR(S) CLAIMED (If applicable)</b>	Color is not claimed as a feature of the mark.
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_631381729-20160426162109692923_.ROA_for_SMART_SHIFT_AND_DRIVE_in_Class_9_F1933396x96B9E_.pdf</a>
<b>CONVERTED PDF FILE(S) (5 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\625\79162545\xml11\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\625\79162545\xml11\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\625\79162545\xml11\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\625\79162545\xml11\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\625\79162545\xml11\RFR0006.JPG</a>
<b>GOODS AND/OR SERVICES SECTION (current)</b>	
<b>INTERNATIONAL CLASS</b>	009
<b>DESCRIPTION</b>	
Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; portable communications apparatus; transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles	

<b>GOODS AND/OR SERVICES SECTION (proposed)</b>	
<b>INTERNATIONAL CLASS</b>	009
<b>TRACKED TEXT DESCRIPTION</b>	
Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; <del>portable communications apparatus;</del> <a href="#">portable apparatus for transmission of communication</a> ; transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles	
<b>FINAL DESCRIPTION</b>	
Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; portable apparatus for transmission of communication; transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles	
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>DESCRIPTION OF THE MARK (and Color Location, if applicable)</b>	The mark consists of the words "Smart Shift and Drive".
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/ctw/
<b>SIGNATORY'S NAME</b>	Charles T.J. Weigell, Esq.
<b>SIGNATORY'S POSITION</b>	Attorney, NY State Bar Member
<b>DATE SIGNED</b>	04/26/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Apr 26 18:11:35 EDT 2016
<b>TEAS STAMP</b>	USPTO/RFR-XX.XXX.XXX.X-20 160426181135459592-791625 45-550a0766dba35a542efd66 b95d7db1e721c136fdeabcc76 5c1b3b25177adc9ef9b-N/A-N /A-20160426162109692923

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **79162545** SMART SHIFT AND DRIVE (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/79162545/large>) has been amended as follows:

### EVIDENCE

#### Original PDF file:

[evi\\_631381729-20160426162109692923 . ROA for SMART SHIFT AND DRIVE in Class 9 F1933396x96B9E .pdf](#)

#### Converted PDF file(s) ( 5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

### CLASSIFICATION AND LISTING OF GOODS/SERVICES

#### Applicant proposes to amend the following class of goods/services in the application:

**Current:** Class 009 for Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; portable communications apparatus; transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles

Original Filing Basis:

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

#### Proposed:

**Tracked Text Description:** Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; ~~portable communications apparatus;~~ [portable apparatus for transmission of communication](#); transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles

Class 009 for Electronic transmitters and receivers for use in automobiles; Computerized vehicle control systems, namely, computer hardware, software and electronic sensors for managing vehicle functions by adjusting the vehicle driving mode and acceleration settings in response to a user's driving preferences; apparatus for wireless transmission of acoustic information; telecommunication transmitting sets; telecommunication transmission apparatus for vehicles; telecommunications transmitters; apparatus for transmission of communication; portable apparatus for transmission of communication; transmitters of electronic signals; apparatus for data transmission; vehicle radios; receivers for satellites; car televisions; navigation apparatus for vehicles; computers; recorded computer operating programs; recorded computer programs for operating land vehicles; data processing apparatus; computer software for encryption; software for processing images, graphics and text; computer programs for editing images, sound and video; operating system programs; communications computers; downloadable computer software for operating land vehicles

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

### ADDITIONAL STATEMENTS

#### Description of mark

The mark consists of the words "Smart Shift and Drive".

**SIGNATURE(S)****Request for Reconsideration Signature**

Signature: /ctw/ Date: 04/26/2016

Signatory's Name: Charles T.J. Weigell, Esq.

Signatory's Position: Attorney, NY State Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79162545

Internet Transmission Date: Tue Apr 26 18:11:35 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.X-20160426181135459

592-79162545-550a0766dba35a542efd66b95d7

db1e721c136fdeabcc765c1b3b25177adc9ef9b-

N/A-N/A-20160426162109692923

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 79/162545

Mark: **SMART SHIFT AND DRIVE** Examiner: Simon Teng

Filed: October 31, 2014 Law Office: 105

Applicant: Hyundai Motor Company

Our Ref: HUND 1503338

**RESPONSE TO OFFICE ACTION**

**NO FEE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Applicant is filing this Request for Reconsideration in response to the Final Action dated October 29, 2016. The Final Action continued the following issues:

- a) The refusal under Trademark Act Section 2(e)(1) based on the asserted mere descriptiveness of the mark. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.63(b);
- b) A required disclaimer of “SHIFT AND DRIVE” apart from the mark;
- c) A requirement to answer specific questions as part of a request for more information;
- d) A more definite description for the goods referenced as “portable communication apparatus”; and,
- e) A requirement for a mark description

Applicant addresses each of these issues in turn, first noting that the Final action is improper as raising incompatible and inconsistent issues, these being a simultaneous refusal of registration and request for disclaimer of a portion of the mark both based on mere descriptiveness.

**IMPROPER FINAL ACTION—NEW ACTION REQUIRED**

Applicant contends that the Final Action is not proper as it includes a refusal of the entire mark based on mere descriptiveness and a required disclaimer of SHIFT AND DRIVE apart from the mark. These issues are incompatible and require clarification with a further action.

These issues were both raised in the First Office Action, and Applicant presented arguments as to the refusal based on mere descriptiveness, believing that the further requirement to disclaim portions of a mark that was entirely refused was mistaken. However, both issues have been

raised again in the Final Office Action leading Applicant to believe that their inclusion was intentional. Given that these two issues are predicated on incompatible and inconsistent findings, Applicant requests that the Final Action be reissued, and that this inconsistency be further explained and reconciled.

A refusal of registration based on mere descriptiveness applies to the entire mark. However, a requirement to disclaim individual elements presupposes that portions of the mark are inherently registrable and can be registered. TMEP Section 1213 states that: “The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant’s right with respect to certain elements in the mark. As stated in *Horlick’s Malted Milk Co. v. Borden Co.*, 295 F. 232, 234 (D.C. Cir. 1924) (citing *Estate of P. D. Beckwith, Inc. v. Comm’r of Pats.*, 252 U.S. 538, 544 (1920)).”

As such, the Final Office action refuses registration because the entire mark is merely descriptive, but also imposes a disclaimer requirement because only a portion of the mark SMART AND DRIVE “merely describes” aspects of Applicant’s goods (see Final Office Action page 4). The disclaimer requirement implies that SMART in Applicant’s mark is registrable, and that Applicant’s mark is entitled to register with a disclaimer of SMART AND DRIVE. If a disclaimer is required, then there must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, that would make the composite registrable. See *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484 (TTAB 2012).

Consequently, the refusal to register on mere descriptiveness grounds implies that no element of the mark is registrable, and that the mark as a whole cannot be registered. This is entirely incompatible and inconsistent with the disclaimer requirement.

This is not a mere academic discussion, if Applicant sought to comply with the disclaimer requirement by disclaiming SMART AND DRIVE, it should permit registration of the mark. But where the mark is also refused on merely descriptive grounds, disclaiming SMART AND DRIVE to comply with the disclaimer requirement serves to admit that the disclaimed wording is merely descriptive and also feeds into an argument that Applicant’s mark is separable, and not unitary nor a slogan, for purposes of arguing against the Section 2(e)(1) rejection. This only puts Applicant at a further disadvantage in its contentions that its mark is registrable as a whole.

The issuance of two incompatible findings, and continuing these and making them Final, is improper, confusing and has the effect of unduly worsening Applicant’s position in arguing and seeking registration of its mark. As such, since Applicant has filed a Request for Reconsideration and Notice of Appeal, and seeks to clarify and narrow all issues on appeal, Applicant submits that a further action is necessary to clarify and reconcile these issues.

#### **MERE DESCRIPTIVENESS REJECTION**

Applicant also reiterates its contentions that the mark is not merely descriptive. The refusal is based on the contention that each element of the mark has an asserted merely descriptive meaning when applied to the named goods. Applicant respectfully traverses the refusal, for the reasons which follow.

Applicant's mark is a compound slogan-type mark, and thus should be viewed as a unitary whole. With all terms contributing to its overall meaning. The Examining Attorney's refusal and contentions improperly separate the terms of the mark from their overall context of use, thus denuding the mark of its meaning and impression in favor of a piecemeal analysis.

The applicable authority is clear that marks must be considered in their entirety and as a whole. *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538 (1920). Even where individual terms may be asserted to be descriptive, numerous cases and decisions show that the combination of terms often presents a suggestive meaning, making the mark inherently registerable. See, for instance, *In Re Frank J. Curran Co.*, 189 U.S.P.Q. 560 ("CLOTHES FRESH" not merely descriptive of clothes and shoe deodorant) and *In re C.J. Webb, Inc.*, 182 U.S.P.Q. 63 (T.T.A.B. 1974) ("BRAKELEEN" not merely descriptive of cleaning composition for automobile brakes). See also, *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 85 (T.T.A.B. 1983) (finding MULTIPOINT for gaskets not merely descriptive), see also: *In re Wisconsin Tissue Mills*, 173 U.S.P.Q. 319 (T.T.A.B. 1972) ("POLYTISSUE" not merely descriptive of combination polyethylene and lightweight paper table covers); *In re Warner Electric Brake and Clutch Co.*, 154 U.S.P.Q. 328 (T.T.A.B. 1967) ("ELECTRO-MODULE" not merely descriptive of electromagnetic brakes and clutches built in modular form); and, *In re Scott Paper Company*, 180 U.S.P.Q. 283 (T.T.A.B. 1973) ("MICRO-WIPES" not descriptive of smaller than normal disposable paper wipers). Applicant submits that the marks found suggestive and not merely descriptive in the above cases impart far more about the respective goods at issue than does Applicant's mark here as to its named goods.

Although Applicant traverses the refusal to register, it seeks in the alternative to prepare its evidence of acquired distinctiveness based on media references and promotional materials. As the mark has only recently been introduced, Applicant will seek to supplement its response to eventually enter a formal amendment under Section 2(f).

#### **REQUEST FOR INFORMATION**

As to the requirement to address specific questions, while noting that the following is based on the understanding of Applicant's counsel, Applicant responds to these as follows.

1. Please describe the specific functionality of applicant's software.

***The software operates automatic transmission technology that analyzes driving style and adjusts shift character, engine torque response and suspension damping in real-time driving conditions.***

2. Please describe the specific functionality of applicant's hardware products.

*The hardware operates automatic transmission technology that analyzes driving style and adjusts shift character, engine torque response and suspension damping in real-time driving conditions.*

3. How do applicant's goods relate to land vehicle gears? Please explain.

*The vehicle gears will still change automatically as with any automatic transmission, either in response to a driver's shifting or in response to acceleration. Applicant's goods change power train and chassis controls based on personal driving styles and road condition to provide drivers with optimal driving performance and experiences.*

4. Do applicant's software and hardware products change or shift land vehicle gears? Please explain.

*No*

5. How do applicant's software and hardware products relate to driving? Please explain.

*They change power train and chassis controls based on personal driving styles and road condition to provide drivers with optimal driving performance and experiences.*

6. Do applicant's software and hardware products control land vehicles? Please explain.

*No, they are not cruise control or similar systems that will drive the car automatically.*

7. How are applicant's goods related to the control and operation of land vehicles? Please explain.

*They change power train and chassis controls based on personal driving styles and road condition to provide drivers with optimal driving performance and experiences.*

8. Are applicant's goods used to control and operate land vehicles? Please explain.

*No, they are not cruise control or similar systems that will drive the car automatically.*

9. Do applicant's goods feature the automated shift of gears and control and operation of land vehicles? Please explain.



No, as explained above.

10. When the driving mode is changed, do the gears shift or change? Please explain.

No.

11. When the driving mode is changed, how are the gears affected? Please explain.

The gears themselves are not affected.

\* \* \*

Lastly, items d) and e) above are readily resolvable.

- Mark Description Requirement

No requirement for a mark description appears in the Final Action. However, reverting back to the first Office Action, Applicant has entered the suggested description there: The mark consists of the words "Smart Shift and Drive."

- A definite ID for the phrase "portable communication apparatus" in Class 9

Applicant has amended this wording to "portable apparatus for transmission of communication" as per the Examining Attorney's suggestion.

### CONCLUSION

Applicant requests that the instant application be approved for publication.

Dated: New York, New York  
April 26, 2016

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU,  
P.C.

By: 

Charles T.J. Weigell

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